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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,888	09/21/2001	Sachiko Tajima	211653US0	2424

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT PAPER NUMBER

1616

DATE MAILED: 12/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/956,888

Applicant(s)

TAJIMA ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

Receipt of Information Disclosure Statement, Amendment E, and Extension of Time received on September 22, 2003 is acknowledged. Claims 1-3, 5-6, and 13-20 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5-6, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2033939 in view XP-002226338.

GB teaches a low ammonia bleach composition. Examples 1 discloses a composition containing 2-20% of an ammonium or alkali earth metal persulfate, perborate, percarbonate, carbonate, 1.5 -7% of hydrogen peroxide, monoethanolamine, a buffer, and water. Note example 1-3. The reference discloses that the composition produces trace amounts of ammonia gas. See page 3, lines 37-45. Additives such as

perfume and essential oils up to 20% is taught on page 3, lines 114-117 and examples.

The composition is maintained at a pH of 9-12. See abstract,

The reference does not specify the perfume utilized.

XP teaches a perfume composition that deodorizes ammonia odor produced by components contained in cosmetics. The perfume composition contains one or more of cis-3-hexenol, geraniol, linalool, terpineol, etc.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings the teachings of GB and XP and include XP's perfume composition into GB's hair composition. One would be motivated to do so to deodorize the ammonia gas that is produced by the hair product taught in GB.

Response to Arguments

Applicant argues that GB '939 does not have examples that contain cis-hexanol and this is a critical feature of the instant invention. The instant invention masks the odor of monoethanolamine. Applicant argues that the secondary reference '338 only teaches that the fragrances incorporated mask the smell of ammonia. It is argued that there is no teaching or suggestion of masking the odor of monoethanolamine.

Applicant's arguments have been fully considered but they are not persuasive. First, the examiner points out that the claims are rejected under prima facie and not under anticipation. Therefore, the primary reference neither has to exemplify formulations or teach every element of the instant invention, or the reference would be said to anticipate the instant invention. The reference merely has to suggest the modification. This is clearly done wherein GB teaches the use of fragrances in the hair

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composition. Further, on page 3, GB teaches that the a cosmetic formulation without that much ammonia gas is pleasing. The only teaching that is lacking is that of the instant fragrance: cis-3-hexanol. The secondary reference supplies the deficiency. The secondary reference teaches the instant fragrance deodorizes the ammonia odor in cosmetics. Therefore, the motivation to utilize the instant invention is to mask the ammonia odor in GB's hair formulation. One would expect similar results since GB teaches the suitability of fragrances in the formulation and the formulation contains ammonia.

Second, the examiner points out that the instant claims are product claim, therefore the function of an ingredient, i.e. cis-hexanol masks monoethanolamine, in a product claim does not hold patentable weight. Thus, the examiner's reason for combining the references may differ from the applicant but the combination yields the same product as the applicant. The fact that applicant has recognized another advantage; i.e. that cis-hexanol masks the odor of monoethanolamine, which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Claims 1-3, 5-6, and 13-20 under are rejected 35 U.S.C. 103(a) as being unpatentable over Yoshida et al (6036730) in view of Fragrance Journal (June 1993) or JP 2001154644.

Yoshida et al teach a hair dye composition. Yoshida teaches hair dye composition that contains instant oxidation dye precursors and instant coupling agents.

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See column 8, lines 24-35. The composition also contains alkalifying agents such as ammonia or alkanoamines (monoethanolamine). See column 8, lines 40-43. Further, the composition may also contain perfumes. See column 8, line 48. Lastly, Yoshida et al teach oxidation hair dye type contains ammonium thioglycolate. See column 8, line 57.

Example B4 teaches a pH 10.

Yoshida et al do not specify the perfume used.

The publication teaches perfumes such as cis-hexenol that mask wave lotions containing ammonium thioglycolates in the base composition. The composition contains 0.1% cis-hexenol applied to a base composition containing ammonium thioglycolate, 1.2% ammonia water, and propylene glycol among other components (Note Table 2 and Table 3).

JP teaches various chemical perfumes such as cis-3-hexenol, lavender, etc to mask odors of the scalp. JP teaches the inclusion of these perfumes in various scalp cosmetics.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings Yoshida et al and the Fragrance Journal and include the instant perfume. One would be motivated to do so since the journal teaches cis-hexenol effectively masks base compositions containing ammonium thioglycolates. Therefore, since Yoshida et al teach a preferred oxidative hair dye formulation containing ammonium thioglycolate, a skilled artisan would reasonably expect cis-hexenol to have similar masking capabilities in Yoshida's composition.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Yoshida et al and JP and include the instant perfume. One would be motivated to do so since JP teaches instant perfumes to effectively mask scalp odors and can be used in cosmetic compositions. Therefore, one would reasonably expect similar results since Yoshida et al teach a hair composition that is applied to the head.

Response to Arguments

Applicant argues that Yoshida is directed to the use of succinoglycan in hair dye compositions. It is argued that oxidation hair dye compositions are only taught on column 8 and only example B4 teaches monoethanolamine with a fragrance. However, it is argued that the instant fragrance is not taught. Applicant argues that the secondary reference teaches that the instant fragrance is used to mask the odor of ammonia and ammonium thioglycolate. It is argued that there is not teaching that the fragrance masks the odor of monoethanolamine.

Applicant's arguments have been fully considered but they are not persuasive. First, the examiner points out that the claims are rejected under prima facie and not under anticipation. Therefore, the primary reference neither has to exemplify formulations or teach every element of the instant invention, or the reference would be said to anticipate the instant invention. The reference merely has to suggest the modification. The primary reference teaches the broad aspect of the claim, a formulation with a fragrance and monoethanolamine with optional ammonium thioglycolate. The

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only teaching that is lacking is the instant fragrance. The secondary teaches the instant fragrance and provides the motivation to utilize it. See rejection above.

In regards to the argument that the patent is direct to succinoglycan, the examiner points out that "the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." See *In re Heck*. In instant case, clearly the reference teaches oxidation hair dyes that containing ammonia, monoethanolamine, fragrances, and may further contain ammonium thioglycolate. See column 8 and example B4. The instant independent claims broadly recite a hair composition containing cis-3-hexanol and monoethanolamine. The open claim language allows for other components in the formulation.

Second, the examiner points out that the instant claims are product claim, therefore the function of an ingredient, i.e. cis-hexanol masks monoethanolamine, in a product claim does not hold patentable weight. Thus, the examiner's reason for combining the references may differ from the applicant but the combination yields the same product as the applicant. The fact that applicant has recognized another advantage; i.e. that cis-hexanol masks the odor of monoethanolamine, which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

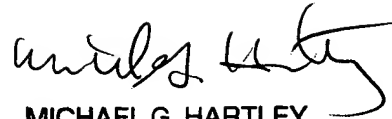
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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Sharmila S. Gollamudi

~~1/18~~
December 17, 2003



MICHAEL G. HARTLEY
PRIMARY EXAMINER